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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,118	06/23/2003	Peter T. Robertson	51865-012	7175

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McDERMOTT, WILL & EMERY
600 13th Street, N.W.
Washington, DC 20005-3096

EXAMINER

BLECK, CAROLYN M

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/601,118

Applicant(s)

ROBERTSON ET AL.

Examiner

Carolyn M. Bleck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 14-20 and 34-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 14-20, and 34-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed on 19 May 2006. Claims 1-10, 14-20, and 34-36 are pending. Claims 11-13 and 21-33 have been withdrawn.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-10, 14-16, 17-20, and 34-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) As per claims 1, 14, 17, and 18, "the perspective insured" lacks proper antecedent basis. For purposes of applying prior art, "the perspective insured" is being interpreted as "the prospective insured." Claims 2-10, 15-16, 19-20, and 34-36 inherit the deficiencies of claims 1, 14, 17, and 18, and are therefore rejected for the same reasons as those claims.

Claim Rejections - 35 USC § 101

4. The rejections of claims 1-10 and 14-20 are hereby withdrawn due to the amendment filed on 19 May 2006.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-10, 14-20, and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gice (Gice, Jon, The Relationship Between Job Satisfaction and Workers Compensation Claims, Society of Chartered Property and Casualty Underwriters, CPCU Journal, September 1995) in view of DeTore et al. (4,975,840).

(A) As per claims 1-4, Gice teaches that personality traits of workers and automobile, bus, and taxi drivers are a major causative factor in workers compensation claims (i.e., the worker having an accident at work) and automobile accidents. The personality traits including impulsivity, aggression, depression, locus of control, and general social maladjustment. General social maladjustment is a person who is self-centered, immature, aggressive, and impulsive. (See pages 5-7).

In addition, Gice teaches that job stress and job satisfaction are causes of workers compensation claims, wherein job satisfaction is defined as a worker's perception of his or her degree of satisfaction with the job. Gice teaches that job satisfaction leads to a number of behaviors including inattentiveness, absenteeism, substance abuse, tardiness, and turnover. Gice teaches that interview protocols are used to measure a worker's perception of job satisfaction, wherein items asked in the interview include sources of job stress such as role ambiguity, lack of recognition, lack of decision making authority, job insecurity, and job unsuitability. See page 5. These portions of Gice read on Applicant's claimed limitations of "providing ... at least one subjective question relating to self perception" and "obtaining a response to the at least one subjective question...".

While Gice teaches that personality traits can correlate with insurance claims, Gice does not expressly disclose a method for analyzing this personality trait data to classify a prospective insured in a risk class.

DeTore discloses a method for evaluating the insurability of a potentially insurable risk comprising:

(a) entering and accessing data in a database containing information collected from an applicant or applicants, including personal data (age, address, occupation, and income level, etc.), medical information (prior medical problems, existing conditions, medications, etc.) and any other information received from the applicant which may have a bearing on insurability, such as depression, smoking or drinking habits, and

avocations, wherein the data is collected based on questions and responses (Fig. 8) (col. 4 lines 24-35, col. 5 line 19-68, and col. 10 lines 43-54);

(b) determining a risk classification for a particular applicant based on data collected including information which may have a bearing on insurability, such as depression, smoking or drinking habits, and certain types of psychological stresses, wherein the classification is performed by an expert module without input from the underwriter (col. 5 lines 19-68, col. 10 lines 43-54, col. 14 line 50 to col. 15 line 18); and

(c) wherein the risk has been defined as the possibility of loss or injury, wherein the possible losses include loss of life, health, property, or finances, wherein in order for the risk to be insurable, the element of chance must be present, i.e., the loss should be caused by an uncertain future event which is not intentionally caused, and wherein property is at risk from environmental sources such as fires and storms as well as from accidents, theft, and vandalism, and wherein information collected in the questionnaire includes motor vehicle reports (col. 1 lines 5-54 and col. 5 lines 19-60).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the features of Gice within the method of DeTore with the motivation of providing an automated system for assessing risk without the aid or intervention of underwriters, thus improving efficiency, quality, and consistency of decisions (DeTore; col. 6 lines 3-10).

It is respectfully submitted that in order to determine whether or not to insure a prospective insuree for motor vehicle insurance, malpractice insurance, and worker's compensation insurance, the probability of an uncertain future event (i.e., causing or

having a car accident, malpractice by a medical professional) is predicted and a rate or premium for this insurance is calculated (DeTore; col. 14 lines 60-65 – discussion of premiums). The skilled artisan would have found it an obvious modification to include calculating an insurance rate based on the risk classification for various types of insurance with the motivation of ensuring insurance companies are able to properly assess the risk of insuring a possible driver for motor vehicle insurance and a medical professional for malpractice insurance, thus reducing financial losses of the company (DeTore; col. 1 lines 5-55).

(B) As per claim 5, Gice discloses the interview protocols and number of psychometric instruments used to measure job satisfaction including role ambiguity, lack of recognition, lack of decision making authority, job insecurity (reads on “locus of control”), and job unsuitability. Gice also discloses that a worker’s state of mind – such as personality traits of aggression and impulsivity, and job stress and job satisfaction can be used. (See pages 5-6).

(C) As per claim 6, Gice discloses correlating age, gender, race, marital status, and educational achievement level with insurance claims (pages 1-2). DeTore teaches automatic classification as discussed in claim 1. The motivation for combining Gice within DeTore is given above in claim 1, and incorporated herein.

(D) As per claim 7, DeTore discloses producing an underwriting decision using the

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personal data (age, address, occupation, and income level, etc.), medical information (prior medical problems, existing conditions, medications, etc.) and any other information received from the applicant which may have a bearing on insurability, such as depression, smoking or drinking habits, and avocations (col. 4 lines 24-35, col. 5 line 19-68, and col. 10 lines 43-54) to determine premiums (col. 13 lines 1-16 and col. 14 lines 13-68). The motivation for combining DeTore within Gice is given above in claim 1, and incorporated herein.

(E) As per claim 8, Gice discloses correlating "personality traits" such as job dissatisfaction, depression, aggression, and impulsivity, with the likelihood of lower back injury (i.e., filing a worker's compensation claim) to make a prediction as to whether a worker is likely to have a lower back injury and file a claim (page 6). Gice also discloses interviewing a person to obtain the data on personality traits (page 5).

(F) As per claim 9, DeTore discloses administering a questionnaire to obtain information from an applicant and recording answers from an applicant on the questionnaire in response to questions relating to information about psychological stresses, avocations, and lifestyle habits (Fig. 8-10, col. 1 lines 5-55, and col. 12 line 37 to col. 13 line 45). As per the recitation of "subjective question," note the teachings of the Gice reference as discussed in claim 1. The motivation for combining DeTore within Gice is given above in claim 1, and incorporated herein.

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(G) As per claim 10, Gice discloses using data regarding a person's anger or frustration (i.e., angry or frustrated), depression (i.e., depressed), social maladjustment (i.e., self-centered, immature, aggressive, and impulsive (pages 2-3). These traits all appear to constitute both a form of personality traits (pages 2-3) and a form of character traits. The remaining features are disclosed in claims 1 and 8, and are incorporated herein.

(H) As per claims 14-16 and 18-20, Gice teaches that personality traits of workers and automobile, bus, and taxi drivers are a major causative factor in workers compensation claims (i.e., the worker having an accident at work) and automobile accidents. The personality traits including impulsivity, aggression (reads on "hostility"), depression, locus of control, and general social maladjustment (reads on "social desirability"). General social maladjustment is a person who is self-centered, immature, aggressive, and impulsive. (See pages 5-7).

In addition, Gice teaches that job stress and job satisfaction are causes of workers compensation claims, wherein job satisfaction is defined as a worker's perception of his or her degree of satisfaction with the job. Gice teaches that job satisfaction leads to a number of behaviors including inattentiveness, absenteeism, substance abuse, tardiness, and turnover. Gice teaches that interview protocols are used to measure a worker's perception of job satisfaction, wherein items asked in the interview include sources of job stress such as role ambiguity, lack of recognition, lack of decision making authority, job insecurity, and job unsuitability. See page 5. These portions of Gice read on Applicant's claimed limitations of "providing ... at least one

subjective question relating to self perception” and “obtaining a response to the at least one subjective question...”.

Gice discloses correlating “personality traits” such as job dissatisfaction, depression, aggression, and impulsivity, with the likelihood of lower back injury (i.e., filing a worker’s compensation claim) to make a prediction as to whether a worker is likely to have a lower back injury and file a claim (page 6). Gice also discloses interviewing a person to obtain the data on personality traits (page 5). (Reads on “generating personality trait data associated with one or more personality traits of the prospective insured based on the response.”)

While Gice teaches that personality traits can correlate with insurance claims, Gice does not expressly disclose a method for analyzing this personality trait data to place an insured in a risk group, wherein the risk classification relates to at least one of accident insurance and a likelihood of filing an accident insurance claim.

DeTore discloses a method for evaluating the insurability of a potentially insurable risk comprising:

(a) entering and accessing data in a database containing information collected from an applicant or applicants, including personal data (age, address, occupation, and income level, etc.), medical information (prior medical problems, existing conditions, medications, etc.) and any other information received from the applicant which may have a bearing on insurability, such as depression, smoking or drinking habits, and avocations (col. 4 lines 24-35, col. 5 line 19-68, and col. 10 lines 43-54);

(b) determining a risk classification for a particular applicant based on data collected including information which may have a bearing on insurability, such as depression, smoking or drinking habits, and certain types of psychological stresses (col. 5 lines 19-68 and col. 10 lines 43-54); and

(c) wherein the risk has been defined as the possibility of loss or injury, wherein the possible losses include loss of life, health, property, or finances, wherein in order for the risk to be insurable, the element of chance must be present, i.e., the loss should be caused by an uncertain future event which is not intentionally caused, and wherein property is at risk from environmental sources such as fires and storms as well as from accidents, theft, and vandalism, and wherein information collected in the questionnaire includes motor vehicle reports (col. 1 lines 5-54 and col. 5 lines 19-60).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the features of Gice within the method of DeTore with the motivation of providing an automated system for assessing risk without the aid or intervention of underwriters, thus improving efficiency, quality, and consistency of decisions (DeTore; col. 6 lines 3-10).

It is respectfully submitted that in order to determine whether or not to insure a prospective insuree for motor vehicle insurance, malpractice insurance, and worker's compensation insurance, the probability of an uncertain future event (i.e., causing or having a car accident, malpractice by a medical professional) is predicted and a rate or premium for this insurance is calculated (DeTore; col. 14 lines 60-65 – discussion of premiums). The skilled artisan would have found it an obvious modification to include

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calculating an insurance rate based on the risk classification for various types of insurance with the motivation of ensuring insurance companies are able to properly assess the risk of insuring a possible driver for motor vehicle insurance and a medical professional for malpractice insurance, thus reducing financial losses of the company (DeTore; col. 1 lines 5-55).

As per the recitation of "likelihood of filing an accident insurance claim," it is respectfully submitted that DeTore's possibility of loss or injury (col. 1 lines 5-54 and col. 5 lines 19-60) is considered to be a form of "the likelihood of filing an accident insurance claim."

(I) Claim 17 repeats the subject matter of method claim 1, respectively, as a computer readable medium bearing instructions, which is executed by a processor rather than as a series of steps. As the underlying processes of claim 1 have been shown to be fully disclosed by the collective teachings of Gice and DeTore in the above rejections of claim 1, it is readily apparent that the system disclosed collectively by DeTore includes a computer readable medium bearing instructions, which is executed by a processor (see DeTore; Fig. 1-2, col. 63 to col. 4 line 35) to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 1, and incorporated herein.

(J) As per claims 34-36, DeTore teaches machine implantation of risk classification using a programmed expert module (col. 14 line 50 to col. 15 line 18).

Response to Arguments

7. Applicant's arguments with respect to claims 14-16, 18-20, and 35-36 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (571) 272-

6767. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (571) 272-6776.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

10. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(571) 273-8300	[Official communications]
(571) 273-8300	[After Final communications labeled "Box AF"]
(571) 273-6767	[Informal/ Draft communications, labeled "PROPOSED" or "DRAFT"]

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Hand-delivered responses should be brought to the Knox Building, Alexandria, VA.

CB

CB

August 15, 2006

A handwritten signature in black ink, appearing to read "Joseph Thomas", written over a horizontal line.

JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER